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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/433,139 | 11/03/1999 | JOHN G. SAVAGE | 8184.00 | 2123 |

7590 07/30/2003

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[REDACTED] EXAMINER

PARTON, KEVIN S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2153 | 18 |

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|--|--------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/433,139 | SAVAGE ET AL. |
| | Examiner Kevin Parton | Art Unit 2153 |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i> | | |
| Period for Reply | | |
| A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. | | |
| <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). | | |
| Status | | |
| 1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>13 May 2003</u> . | | |
| 2a) <input type="checkbox"/> This action is FINAL. 2b) <input checked="" type="checkbox"/> This action is non-final. | | |
| 3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213. | | |
| Disposition of Claims | | |
| 4) <input checked="" type="checkbox"/> Claim(s) <u>22-30</u> is/are pending in the application. | | |
| 4a) Of the above claim(s) _____ is/are withdrawn from consideration. | | |
| 5) <input type="checkbox"/> Claim(s) _____ is/are allowed. | | |
| 6) <input checked="" type="checkbox"/> Claim(s) <u>22-30</u> is/are rejected. | | |
| 7) <input type="checkbox"/> Claim(s) _____ is/are objected to. | | |
| 8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement. | | |
| Application Papers | | |
| 9) <input type="checkbox"/> The specification is objected to by the Examiner. | | |
| 10) <input type="checkbox"/> The drawing(s) filed on _____ is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). | | |
| 11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action. | | |
| 12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner. | | |
| Priority under 35 U.S.C. §§ 119 and 120 | | |
| 13) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) <input type="checkbox"/> All b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. | | |
| 14) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received. | | |
| 15) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121. | | |
| Attachment(s) | | |
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | | |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | | |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | | |
| 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ | | |
| 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) | | |
| 6) <input type="checkbox"/> Other: _____ | | |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 22-30 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 22-25 and 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Suer et al. (USPN 6,431,439).

4. Regarding claim 22, Suer et al. (USPN 6,431,439) teach a system for providing a receipt to a customer at a self-service terminal with means for:

- a. Establishing wireless communication with a portable device retained by the customer (column 12, lines 35-40; figure 2c).

- b. Preparing data relating to a transaction that has been executed at the self-service terminal (column 12, lines 41-43).
- c. Transferring the prepared data to the portable device via the wireless communication to provide the customer with an electronic receipt for storage in the portable device (column 12, lines 44-48).

5. Regarding claim 23, Suer et al. (USPN 6,431,439) teach all the limitations as applied to claim 22. The further teach means wherein the step of establishing wireless communication includes the step of transmitting data on an infrared carrier signal (column 9, lines 29-35).

6. Regarding claim 24, Suer et al. (USPN 6,431,439) teach all the limitations as applied to claim 22. They further teach means for preparing data relating to general financial information prior to the step of transferring the prepared data (column 12, lines 35-48). Note that the transaction may be with an ATM which would provide general financial information.

7. Regarding claim 25, Suer et al. (USPN 6,431,439) teaches all the limitations as applied to claim 22. They further teach means for preparing data relating to personal financial information prior to the step of transferring the prepared data (column 12, lines 35-48). Note that the transaction may be an ATM or a sale point and thus general or personal financial data.

8. Regarding claim 28, Suer et al. (USPN 6,431,439) teach a system for providing a statement to a customer at a self service terminal with means for:

- a. Establishing wireless communication with a portable device retained by the customer (column 12, lines 35-40; figure 2c).
- b. Preparing data relating to one or more transactions that have been executed for the customer (column 12, lines 41-43).

c. Transferring the prepared data to the portable device via the wireless communication to provide the customer with an electronic statement for storage in the portable device (column 12, lines 44-48).

9. Regarding claim 29, Suer et al. (USPN 6,431,439) teach a system for providing a receipt or statement to a customer at a self service terminal comprising:

- a. A digital data port for establishing wireless communication with a portable device retained by the customer (column 12, lines 35-40; figure 2c).
- b. Means for preparing data relating to one or more transactions that have been executed for the customer (column 12, lines 41-43).
- c. Digital data transfer means for transferring the prepared data to the portable device via the digital data port to provide the customer with an electronic receipt or a statement relating to the one or more transactions that have been executed for the customer (column 12, lines 44-48).

10. Regarding claim 30, Suer et al. (USPN 6,431,439) teach all the limitations as applied to claim 29. They further teach identifier means in the vicinity of the digital data port for facilitating location of the port by the customer (column 9, lines 29-35; figure 2b).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suer et al. (USPN 6,431,439) in view of Slotznick (USPN 6,108,640).

13. Regarding claim 26, Suer et al. (USPN 6,431,439) teaches a self service terminal with means for:

- a. Establishing wireless communication with a portable device retained by a customer at the self-service terminal (column 12, lines 35-40; figure 2c).
- b. Preparing data relating to a transaction that has been executed at the self-service terminal (column 12, lines 41-43).
- c. Transferring the prepared data to the portable device via the wireless communication to provide the customer with an electronic receipt (column 12, lines 44-48).

Although the system disclosed by Suer et al. (USPN 6,431,439) shows substantial features of the claimed invention, it fails to disclose means for reading personal information from the portable device to build a profile of the customer.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Suer et al. (USPN 6,431,439), as evidenced by Slotznick (USPN 6,108,640).

In an analogous art, Slotznick (USPN 6,108,640) discloses a system for interaction of a portable digital device (PDD) with a digital network with means for reading personal information from the portable device to build a profile of the customer (column 26, lines 30-33; figure 3).

Given the teaching of Slotznick (USPN 6,108,640), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Suer et al. (USPN 6,431,439) by obtaining customer information during use to build or add on to an existing customer profile. This would allow the system to more quickly present user preferences and to keep statistical information as to usage in different locations. This specialized information benefits the system by allowing for targeted advertising and faster service for customers.

14. Regarding claim 27, although the system disclosed by Suer et al. (USPN 6,431,439) (as applied to claim 26) shows substantial features of the claimed invention, it fails to disclose means for:

- a. Analyzing the personal information read from the portable device retained by the customer.
- b. Storing the analyzed information in a database entry for the customer.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Suer et al. (USPN 6,431,439), as evidenced by Slotznick (USPN 6,108,640).

In an analogous art, Slotznick (USPN 6,108,640) discloses a system for interaction of a portable digital device (PDD) with a digital network with means for:

- a. Analyzing the personal information read from the portable device retained by the customer (column 26, lines 30-33; figure 3).
- b. Storing the analyzed information in a database entry for the customer (column 26, lines 30-36).

Given the teaching of Slotznick (USPN 6,108,640), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Suer et al. (USPN 6,431,439) by obtaining customer information during use to build or add on to an existing customer profile. This would allow the system to more quickly present user preferences and to keep statistical information as to usage in different locations. This specialized information benefits the system by allowing for targeted advertising and faster service for customers.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Parton whose telephone number is (703)306-0543. The examiner can normally be reached on M-F 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703)305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are (703)746-9242 for regular communications and (703)746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Kevin Parton
Examiner
Art Unit 2153

ksp
July 22, 2003



GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
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